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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,128	11/19/2003	James T. Olsta	28570/10087	9107

4743 7590 07/18/2006

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EXAMINER

MENON, KRISHNAN S

ART UNIT PAPER NUMBER

1723

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

✓

Office Action Summary	Application No. 10/718,128	Applicant(s) OLSTA ET AL	
	Examiner Krishnan S. Menon	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-29,35-37 and 39-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-29,35-37 and 39-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 12-29, 35-37 and 39-44 are pending as amended 6/23/06

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 12, 13, 35-37 and 39-44 are rejected under 35 U.S.C. 102(b) as being anticipated by White (US 5,237,945).

Claims 12, 13: White'945 teaches a method of manufacturing a geotextile mat by pre-forming the mat, then filling the voids in the mat with the active material, then adhering a liquid-permeable cover-sheet (woven or non-woven) on the mat with a water insoluble (solvent-based) adhesive to one or both major surfaces as claimed. See figures 1-3, abstract, column 3 lines 31-55, column 7 line 60 – column 8 line 33 and column 10 lines 15-28. Regarding the opening size of the mat, see column 8 lines 10-13 and 22-32: porosity sufficient to receive the particles; particle sizes 0.02-15 mm. With respect to the limitation of 'preformed geotextile mat', the geotextile mat in the reference is formed on the machine before filling the powders, and thus is 'pre-formed'.

With respect to the newly added limitation of 'powdered or granular material does not prevent the flow of water through the geocomposite article', White in column 4 lines 40-63 teaches that water absorbent material can be omitted or sufficient porosity can be

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provided at certain portions of the geocomposite material. This paragraph of the reference also incorporates US Patent 5,043,076 by reference. The '076 patent teaches a geocomposite membrane that "does not prevent the flow of water through the membrane" as claimed (see abstract, column 2 lines 23-34, 36-57, and column 3 lines 4-12). Therefore, the White reference anticipates the claims. In addition, the claim language, "powdered or granular material does not prevent the flow of water ..." is an inherent property of the material itself. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d, 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). This claim language does not necessarily mean that the article of manufactured by the process of the claim does not prevent flow of water through it.

Claims 35, 37: zeolite, etc – column 3 lines 40-50. % Bentonite (water absorbent) – column 9 lines 50-60 – encompasses the range claimed.

Claims 36,42: fiber materials: polyester, etc. – see column 17 lines 1-30.

Claim 39: particle mesh size – see column 8 lines 22-32.

Claims 40, 41: Reference teaches fiber density in the mat at 1-50 oz/sq ft (column 8 lines 14-20) and powder filling at ¼ to 30 lbs/sq.ft. (column 13 lines 45-52), which would show that the volume % of the powder falls in the ranges claimed.

Claims 43 and 44: the mat and the cover sheets are non-woven as claimed: mat is laid as non-woven. The sheet is non-woven – see column 10 lines 15-20.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over White'945.

Claim 23 differs from the teaching of the reference in that the second layer of geotextile mat is formed in situ and adhered on the first layer of geotextile mat; the claim recites a pre-formed mat is adhered over the first layer. However, this difference would not make the claim patentable because it only eliminates the process steps of making the mat elsewhere and then bringing it in to apply over the first layer. Omission of an Element and Its Function Is Obvious If the Function of the Element Is Not Desired. Ex parte Wu , 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989). See also In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) and In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

Adhering second and subsequent layers of geotextile mat, including partially or wholly filled layers, and cover sheets, are taught in figure 6 a-c, and column 13 line 19 – column 14 line 35, column 15 lines 1-27.

With respect to the newly added limitation of 'powdered or granular material does not prevent the flow of water through the geocomposite article', see the rejection of claim 12 above.

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3. Claims 14-16 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over White'945 as applied to claim 12 above, and further in view of White (US 5,346,565) and/or Clarey et al (US 5,900,085).

Instant claims differ from the teaching of White'945 in the process of covering of all edges as claimed. However, covering the edges to prevent fall out of the filler material by sewing the edges together, needle-punching, gluing, etc are known in the art, as seen in White'565 and Clarey, and is unpatentable. See White'565 column 1 lines 35-58 and Clarey column 2 lines 46-67.

4. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over White'945 as applied to claim 12 above, and further in view of Zhou et al (US 6,610,781).

Instant claims differ from the teaching of White'945 in the step of vibration or vacuum to spread the powder into the mat. Zhou teaches vibration or vacuum for spreading a powder into a porous substrate for distributing the powder in the substrate (see claim 7 of Zhou and column 10 line 57 column 11 line 4). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Zhou in the teaching of White'945 to have vibration or vacuum applied for distributing the powder intimately into the porous mat.

Response to Arguments

Applicant's arguments filed 6/23/06 have been fully considered but they are not persuasive.

The applicant, by the newly added amendment, intended to make the claims read as if the article of manufacture permeates water as opposed to the intent of the White patent, which is intended to prevent water passage through the article. However, as pointed out in the rejection, White reference, by incorporating the '076 patent, does anticipate the claims. In addition, the claim language does not recite the applicant's intent; it only recites that the material used in the article are permeable to water.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Handwritten signature of Krishnan S Menon and the date 7/10/06.

Krishnan S Menon
Examiner
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